

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SOLOMON S. STEINER, ROBERT FELDSTEIN, PER B. FOG, and
TRENT POOLE

Appeal 2007-0742
Application 09/621,092
Technology Center 3700

Decided: April 30, 2007

Before ANITA PELLMAN GROSS, ROBERT E. NAPPI, and LINDA E.
HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 30, 41, and 43-45. Claims 28 and 29 are objected to as being

Appeal 2007-0742
Application 09/621,092

dependent upon a rejected base claim, and claims 1-27, 31-40, and 42 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants' claimed invention is to a capsule containing a medicament for use in an inhaler. Claim 41, reproduced below, is representative of the subject matter on appeal.

41. A capsule to contain drug for use in an inhaler comprising at least one keying surface on an outside surface of a distal end of the capsule that is adapted to orient the capsule within the inhaler or identifies the drug to be placed in the capsule and at least one hole allowing air to pass in, through and out of the capsule.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Keritsis US 4,991,605 Feb. 12, 1991

The following rejection is before us for review.

1. Claims 30, 41, and 43-45 stand rejected under 35 U.S.C. § 102(b) as anticipated by Keritsis.

Appeal 2007-0742
Application 09/621,092

ISSUE

Appellants contend that Keritsis does not disclose a capsule or a keying surface on an outside surface of a distal end of a capsule as required by claim 41 (Br. 6). Appellants further contend that Keritsis does not disclose a keying surface that orients the capsule within an inhaler, as required by claims 43 and 45 (Br. 8). Appellants further contend that Keritsis does not disclose how or where one would place an identifier for the drug to be placed in the capsule, as required by claims 44 and 45, and does not disclose including a medicament in the capsule, as required by claim 30 (Br. 8). The Examiner contends Keritsis discloses a capsule (610) to contain drug for use in an inhaler (620), the capsule having at least one keying surface (613, 619, 623) on an outside surface of a distal end of the capsule that is adapted to orient the capsule within the inhaler or identifies the drug to be placed in the capsule, and at least one hole (615, 617) allowing air to pass in, through and out of the capsule (Answer 3). The issue before us is whether Appellants have shown that the Examiner erred in finding that Keritsis anticipates the subject matter of claims 30, 41, and 43-45.

FINDINGS OF FACT

We find that the following findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Appeal 2007-0742
Application 09/621,092

1. Keritsis discloses a container for containing an additive material to modify the characteristics of a smoking article, e.g. "conventional tobacco containing smoking articles, articles that deliver uncombusted air, or uncombusted aerosol or substantially tasteless gases to the smoker..." (Keritsis, col. 3, ll. 37-43 and col. 7, ll. 49-53).

2. The container of Keritsis is hermetically sealed prior to use and unsealed to release the active agent to be delivered to the smoker (Keritsis, col. 2, ll. 8-12). Keritsis discloses that "[t]he container is configured to be located in the 'smoke' stream of a smoking article, preferably proximate to or at the mouth end of the article" (Keritsis, col. 2, ll. 26-28).

3. With reference to Figures 6 and 7, Keritsis discloses a container 600 comprising an element 610 with an axially-grooved outer surface 613 and an element 620 with an axially grooved inner surface 623 (Keritsis, col. 5, ll. 51-57).

4. As shown in Figure 7, the axially-grooved outer surface 613 extends along the outer surface to a distal end, i.e., the end of element 610 adjacent end surface 616, and is used to orient element 610 within element 620 by alignment of this outer surface 613 with the axially-grooved inner surface 623 of element 620 (Keritsis, Figure 7).

5. Keritsis discloses that element 610 is open at one end and closed at the other end by surface 616, and contains perforations 615 and 617 in the periphery at the open and closed ends (Keritsis, col. 5, ll. 66-68). Keritsis discloses that in an alternate embodiment, the open end of element 610 could be closed (Keritsis, col. 6, ll. 7-8).

Appeal 2007-0742
Application 09/621,092

6. Keritsis discloses that when the container 600 is activated, the covered perforations are opened to allow air pathways through the inside of element 610 (Keritsis, col. 6, ll. 18-23).

7. A “medicament” is “an agent that promotes recovery from injury or ailment; a medicine” (Br., Evidence App., citing *The American Heritage® Dictionary of the English Language* (4th ed. 2000)).

8. Keritsis discloses that the additive materials contained within the container include menthol (Keritsis, col. 8, l. 2).

9. Menthol is an agent that acts as a mild topical anesthetic and, as such, is a medicament. *The American Heritage® Dictionary of the English Language* (4th ed. 2000) (<http://www.bartleby.com/61/20/M0222000.html>).

10. An inhaler is a device that produces a vapor to ease breathing or is used to medicate by inhalation, especially a small nasal applicator containing a volatile medicament. *The American Heritage® Dictionary of the English Language* (4th ed. 2000) (<http://www.bartleby.com/61/20/I0142000.html>).

11. Keritsis’s elements 620 and 630 and the remainder of the smoking article form a device that is used to medicate by delivering menthol to a smoker by inhalation. Keritsis’s capsule 610 contains the menthol additive and is adapted to be used within this device.

12. Keritsis does not disclose using the keying surface to identify the additive to be placed in the container.

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

ANALYSIS

Appellants argue that Keritsis does not disclose a “capsule,” as required by claim 41, because element 610 of Keritsis is disclosed as open at one end and closed at the other end by surface 616 (Br. 7). We disagree. Keritsis discloses a container, having an element 610 that is closed on both ends (FF 5). As such, element 610 of Keritsis’s container is a capsule.

Appellants further contend that “even if element 610 was considered to be a ‘capsule’, it lacks one or more keying surfaces on its distal ends” (Br. 7). Appellants’ argument does not comport with the language of claim 41. Claim 41 recites, “A capsule . . . comprising at least one keying surface on an outside surface of a distal end of the capsule....” The plain meaning of the recited “outside surface of a distal end” is broad enough to include the perimeter of the distal end surface. Taking element 610 as the capsule, we find that capsule 610 has an axially-grooved outer surface 613 that extends along an outside surface thereof to the perimeter or outside surface of distal end 616 (FF 3, 4). While the Specification discloses embodiments of the capsule having keying surfaces located only on the closed end surfaces of the capsule, such a configuration is not claimed by the broad

Appeal 2007-0742
Application 09/621,092

language of claim 41, and we see no evidence from the Specification that would require us to incorporate limitations from a specific embodiment into the language of the claim.

Appellants further contend that Keritsis does not disclose a keying surface that orients the capsule within an inhaler, as required by claims 43 and 45¹ (Br. 8). In particular, Appellants argue that Keritsis requires a wrapper to keep the smoking article and the container 600 connected to each other and oriented in the desired position (Br. 8). We find this argument unpersuasive when the capsule is defined as element 610, because elements 620 and 630 and the remainder of the smoking article form an inhaler² that is used to deliver the menthol additive to the smoker upon inhalation, and the keying surface 613 of capsule 610 orients the capsule within the inhaler (FF 4, 11). Also, the device of Keritsis is an inhaler because Keritsis discloses that the container 600 is disposed at the mouth end of the smoking article (FF 2) such that a smoker might place his mouth directly on the element 620 and inhale during use to deliver the menthol additive to the smoker.

Appellants further contend that Keritsis fails to disclose that the keying surface identifies the drug to be placed in the capsule, as required by claims 44 and 45 (Br. 8). We agree with Appellants. We find no disclosure in Keritsis that the

¹ We note that claim 41 also includes this limitation, albeit recited with the limitation that the capsule is adapted to identify the drug to be placed in the capsule.

² An inhaler is a device that produces a vapor to ease breathing or is used to medicate by inhalation, especially a small nasal applicator containing a volatile medicament (FF 10).

Appeal 2007-0742
Application 09/621,092

keying surface 613 or any other element of container 600 identifies the additive within the container (FF 12).

Appellants further contend that Keritsis does not disclose including a medicament in the capsule, as required by claim 30 (Br. 8). The capsule 610 of Keritsis contains an additive material for use in a smoking article (FF 1, 2). The additive material may be menthol, which is a drug or medicament, used as a mild topical anesthetic (FF 7-9). As such, Keritsis discloses including a medicament in capsule 610.

CONCLUSIONS OF LAW

We conclude Appellants have not shown that the Examiner erred in finding claims 30, 41, and 43 anticipated by Keritsis. We conclude, however, that Appellants have shown the Examiner erred in finding claims 44 and 45 anticipated by Keritsis.

DECISION

The Examiner's rejection of claims 30, 41, and 43 under 35 U.S.C. § 102(b) is sustained, and the Examiner's rejection of claims 44 and 45 under 35 U.S.C. § 102(b) is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

Appeal 2007-0742
Application 09/621,092

AFFIRMED-IN-PART

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PATREA L. PABST
PABST PATENT GROUP, LLP
400 COLONY SQUARE, SUITE 1200
1201 PEACHTREE STREET
ATLANTA, GA 30361